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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,619	01/29/2004	Mark V. Vandewalle	5490-000363	5659

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HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER

HILL, GENEVIEVE A L

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/767,619	VANDEWALLE, MARK V.	
	Examiner	Art Unit	
	Genevieve A-L. Hill	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 26-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/9/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I (claims 1-25) in the reply filed on November 14, 2005 is acknowledged. The traversal is on the ground(s) that the field of search for each group should be essentially coextensive. This is not found persuasive because the method claims are so broad that the search could go out of the class as shown in the catheter example given in the original restriction requirement. Therefore, the search for the apparatus may not be the same search for the method and would be a burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claims 26-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 14, 2005.

Information Disclosure Statement

2. The information disclosure statement submitted on January 29, 2004 is acknowledged and complies 37 CFR 1.97 and 1.98. Therefore, the references listed therein have been considered by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9, 18, 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Moreira (US Patent 2243717). Moreira discloses a cannulated medical instrument in Figure 1 used to treat bone fractures by inserting a medical device. For claims 1 and 21, the entire device in Figure 1 is cannulated to accommodate guide wire 10 along clasp device 12, follower member 15, and driver member 20. The clasp device 12 is connected to the follower member 15, which is connected to the driver member 20. For claim 2, Moreira discloses a cannulated engaging member at 28 where medical device S is connected to the driver member 20. Referring to claims 3 and 22, the follower member is internally threaded through neck 19 (Figure 4 and Column 2, line 13).

For claim 4, the driver member 20 is threaded and rotateably connected to follower member 15 (column 2, lines 13-15). Referring to claim 5, since the follower member 15 is engaged to the driver member 20 via neck 19, and the follower member becomes disengaged from the neck during counter-clockwise rotation and therefore moves away distally (column 4, paragraph 2). For claims 6, 13, and 23, the medical device S has threads 23 on the distal end. For claims

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7-9, 14-16, and 24, Moreira's device is capable of having equal, less, or greater thread pitches for the driver member 20 and the medical device S in order to change the insertion/extraction rates. Therefore, it is inherent to vary the thread pitch to achieve the desired insertion/extraction rates. The further limitations in these claims 7-9, 14-16, and 24 involve conditional statements, which means that the phrases following "when" are not positive recitation of features.

Referring to claim 18, the device is hand-driven via follower member 15 and clasp device 12.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10-12, 13-17, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moreira in view of Gotfried (US Patent 5429641). Moreira discloses the cannulated device according to claims 1 and 3, and for claim 13, Moreira teaches a medical device S with threads 23 on the distal end. For claims 14-16, Moreira's device is capable of having equal, less, or greater thread pitches for the driver member 20 and the medical device S in order to change the insertion/extraction rates. Therefore, it is inherent to vary the thread pitch to achieve the desired insertion/extraction rates. Moreira's device but does not

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include a clasping device that moves when the driver of follower rotates and holds the guide wire rotationless. However, Gotfried teaches a surgical device with grip 45 engaged to follower 59. For claims 10 and 12, all "components can be axially moved relative to each other" and can therefore move during rotation of each segment (column 6, lines 24-25). Referring to claims 11, 17 and 25, the stop 57 engages the inner sleeve while the driver and follower members maintain rotation since their rotation means 62 are detached from the clasping device (Figures 11 and 17). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Moreira's device with a clasping device that moves when the driver of follower rotates and holds the guide wire rotationless. This modification would allow Moreira's instrument to have additional axial motion (column 6, line 26) and to have control over the motion of the inner sleeves (column 6, lines 54-63).

5. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moreira in view of Moran et al (US Patent 5697935). Moreira discloses the cannulated device according to claim 1, but does not include an electric or pneumatic motor. However, Moran et al teach a drill 60 used to remove bone implants which can be powered by an electric motor or pneumatic motor (column 6, line 42). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Moreira's device with an electric or pneumatic motor since such a modification would allow the drill to have a higher number of revolutions (column 6, lines 43-50).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Genevieve A-L. Hill whose telephone number is (571) 272-7226. The examiner can normally be reached on Monday through Friday from 9:00am to 5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GAH


David H. Wilse
Primary Examiner